

REMARKS

Claims 1-46 are pending. Claims 1 and 33 are amended.

Claim Rejection – 35 U.S.C. § 101

The Examiner rejected Claims 1-46 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Pursuant to the Examiner's suggestion, Claim 1 is now amended to recite: "a subscriber profile database provided in a non-transitory computer readable medium ...". Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 101 is overcome.

Claim Rejections – 35 U.S.C. § 103

Claims 1-8, 10, 13, and 46 over Enyart and Coleman

The Examiner substantially repeated his previous rejection in the Office Actions of May 8, 2009 and November 30, 2009 ("Previous Office Actions") of Claims 1-8, 10, 13, and 46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2006/0041505 to Enyart (*Enyart*) in view of U.S. Patent Publication No. 2007/0083438 to Coleman (*Coleman*).

In response to each of the Previous Office Actions, Applicant repeatedly explained, for example, in the Amendment of January 27, 2010 ("Previous Amendment"), that the Examiner's *Enyart-Coleman*-based arguments against Claim 1 result from an erroneous understanding of Claim 1. Specifically, Applicant explained in the Previous Amendment that the fact that "potential purchaser is only available for presentation to other potential advertisers after the potential purchaser has actually registered to receive an advertisement" is not relevant to the transaction tracking service recited in Applicant's Claim 1. Applicant's Claim 1 recites a transaction tracking service as follows:

a transaction tracking service which detects registration messages or confirmation messages received by each subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database and which extracts from the detected registration messages or confirmation messages information regarding the subscriber's on-line activities;

(emphasis added)

The underscored limitations set forth that the transaction tracking service detects and extracts information from registration messages received by the subscriber at the subscriber's electronic addresses. In contrast, *Coleman* teaches that a potential purchaser directly provides the information to its "system proprietor." This difference is significant. While *Coleman*'s system proprietor is already informed of the potential purchaser's interest directly through its registration process, to meet Claim 1's limitation, the Examiner's arguments would have *Coleman*'s system proprietor extract that information it already possesses from the system proprietor's own registration messages sent to the potential purchasers at the potential purchaser's electronic addresses. Not only is such a procedure absurd, it is not taught in *Coleman*.

In addition, Applicant further pointed out in the Previous Amendment that, contrary to the Examiner's contention, *Coleman*'s paragraph [0072] does not teach tracking of registration messages received at the subscriber's electronic addresses. When a subscriber in *Coleman* updates its profile via email, such a subscriber would send the update to an email address of the "system proprietor." Such an email would not be a "[registration message] received by each subscriber at one or more of the subscriber's electronic addresses." As to sources of outside information accessed by *Coleman*'s system proprietor, *Coleman*'s paragraph [0072] never once discloses that the information may be derived from "registration messages received by each subscriber at one or more of the subscriber's electronic addresses":

... The registered user's profile may also be updated by receiving transaction information from transactions effected by the registered user through entities other than the system proprietor of the present invention. In one embodiment, for instance, a registered user may provide access to credit card databases that would allow the registered user's profile to be updated. The act of updating may also involve gathering additional information about the potential purchaser from outside information sources after getting permission from the potential purchaser to do so. Information could be gathered from various online sources, credit bureaus, government databases, credit card companies, and any other information providers.

(Coleman, at paragraph [0072])

Therefore, from the description of *Coleman*'s paragraph [0072] quoted above, *Coleman* in fact teaches that the system proprietor gathers addition information of the potential purchaser directly from outside information sources – not from registration messages received by the subscriber at its electronic addresses -- upon authorization by the potential purchaser.

In the Office Action of November 30, 2009, the Examiner further argues:

The Examiner notes that each potential purchaser is required to register in order to be recognized as such. Furthermore Coleman disclosed a potential user signing up for a deal which is equivalent to a registration process. Since Coleman involves updating profiles with new information regarding the said deals, wherein the new information is captured during the sign-up process (*'registration'*) then Coleman disclosed tracking responses to registration messages.

In response, Applicant pointed out in the Previous Amendment that the Examiner is also mistaken in this argument. In the above-quoted arguments, the Examiner concludes that “*Coleman* disclosed tracking responses to registration messages.” However, tracking “responses to registration messages” is not relevant to Applicant’s Claim 1, which recites the “transaction tracking service [detecting] registration messages or confirmation messages received by each

subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database," not responses to such registration messages.

Even under the Examiner's arguments, *Coleman*'s user updates its profile by the user providing new information to the system proprietor during the registration process. What the Examiner argues as the "registration messages" are in fact messages that are sent by the subscriber, not received by the subscriber, as recited in Applicant's Claim 1. In other words, even the Examiner arguments do not lead not the conclusion that *Coleman*'s teaches "registration messages ... received by each subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database." Therefore, *Coleman* does not teach or suggest tracking "registration [] messages received by each subscriber at one or more of the subscriber's electronic addresses."

Therefore, in the Previous Amendment, Applicant respectfully submits that the Examiner's *Coleman*-based arguments against Claim 1 results from an erroneous understanding of Claim 1.

In response to Applicant's arguments of the Previous Amendment, the Examiner first contends in the present Office Action:

The Applicant presents the following argument(s) [in italics]:

[The prior art does not disclose] a transaction service which extracts from the detected registration messages or confirmation messages information regarding the subscriber's on-line activities.

The Examiner respectfully disagrees with the Applicant.

Coleman Paragraph 10 disclosed effecting for the at least one potential purchaser one or more purchase transactions and collecting resulting transaction information in the electronic file, and preparing from at least the information above a profile for the

at least one potential purchaser that is updated regularly.

Once again, the Examiner ignores that Claim 1 recites registration messages that are “received by each subscriber at one or more of the subscriber’s electronic addresses included in the subscriber profile database.” *Coleman*’s paragraph 10 neither discloses nor suggests such a limitation:

[0010] One embodiment of the invention is a method for compiling in a host computer system a purchaser profile for inclusion in a pool of purchaser profiles. The method comprises collecting in an electronic file in the host computer system identification and residence location information for at least one potential purchaser, and registering the at least one potential purchaser with the host computer system, collecting in the electronic file profile information provided by the at least one potential purchaser, effecting for the at least one potential purchaser one or more purchase transactions and collecting resulting transaction information in the electronic file, and preparing from at least the information above a profile for the at least one potential purchaser that is updated regularly....

(emphasis added)

Therefore, not only does *Coleman* neither discloses nor suggests Claim 1’s limitation discussed above, *Coleman*’s paragraph 10 in fact teaches that information is collected from (a) the potential purchaser directly (not from messages received by the potential purchaser), and (b) information resulting from the host computer system effecting the purchaser’s purchasing transactions. The Examiner further argues:

Furthermore *Coleman* Paragraph 97 disclosed wherein the potential purchasers are required to post an indication of purchaser interest in that offer to sign up for the deal.

The Examiner notes that the signup process by *Coleman* is equivalent to the registration message as claimed because they are collecting user information regarding user interests. Since *Coleman* is tracking both the registration and the related transaction information until the completion of user purchase, the profile by *Coleman* is thus detecting registration messages or confirmation

messages information regarding the subscriber's on-line activities.

Therefore, in this argument also, even while recognizing that *Coleman* teaches the potential purchaser posting the sign-up information, the Examiner continues to ignore Claim 1's recitation that the registration messages are "received by each subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database."

Thus, all of the arguments that the Examiner made in the current and Previous Office Actions fail because the combined teachings of *Enyart* and *Coleman* fail to disclose or suggest "detects registration messages or confirmation messages received by each subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database and which extracts from the detected registration messages or confirmation messages information regarding the subscriber's on-line activities." Accordingly, Claims 1 and dependent Claims 2-8, 10, 13 and 46 are each allowable over the combined teachings of *Enyart* and *Coleman*. Reconsideration and allowance of Claims 1-8, 10, 13 and 46 are therefore requested.

Claim 11 over Enyart, Coleman, and Law

The Examiner rejected Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman*, and further in view of U.S. Patent Publication No. 2006/0229934 ("*Law*").

As Claim 11 depends from Claim 1, Claim 11 is patentable over the combined teachings of *Enyart* and *Coleman* for the reasons already stated above. As the Examiner cites *Law* for merely teaching forwarding of email, *Law* does not cure the deficiencies of *Enyart* and *Coleman*. Thus, Claim 11 is patentable over the combined teachings of *Enyart*, *Coleman*, and *Law*. Reconsideration and allowance of Claim 11 are therefore requested.

Claim 12 over Enyart, Coleman, Law, and Kubic

The Examiner rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman*, and further in view of *Law* and U.S. Patent No. 6,959,324 (“*Kubic*”).

As Claim 12 depends from Claim 1, Claim 12 is patentable over the combined teachings of *Enyart*, *Coleman*, and *Law* for the reasons already stated above. As the Examiner cites *Kubic* merely for disclosing probe messages, *Kubic* does not cure the deficiencies of *Enyart*, *Coleman* and *Law*. Thus, Claim 12 is patentable over the combined teachings of *Enyart*, *Coleman*, *Law*, and *Kubic*. Reconsideration and allowance of Claim 12 are therefore requested.

Claims 14-21, 24-26, 31-33, 37-45 over Enyart, Coleman, and Goodwin

The Examiner rejected claims 14-21, 24-26, 31-33, and 37-45 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman* and U.S. Patent Publication No. 2003/0163485 (“*Goodwin*”).

As set forth above, Claim 1, from which Claims 14-21, 24-26, 31-33, 37-45 depend, is patentable over *Enyart* and *Coleman*. As the Examiner cites *Goodwin* merely for teaching information stored in a database, *Goodwin* does not cure the deficiency of *Enyart* and *Coleman*. Therefore, dependent Claims 14-21, 24-26, 31-33, 38-45 are patentable over the combined teachings of *Enyart*, *Coleman*, and *Goodwin*. Therefore, Applicant respectfully submits that Claim 1 and dependent Claims 2-6, 8, 10, 13 and 46 are each patentable under 35 U.S.C. § 103(a) over the combined teachings of *Enyart*, *Coleman*, and *Goodwin*. Reconsideration and allowance of Claims 1-6, 8, 10, 13 and 46 are therefore requested.

Reconsideration and allowance of Claims 14-21, 24-26, 31-33, 37-45 are therefore requested.

Claims 22-23 over Enyart, Coleman, Goodwin, and Fratkina

The Examiner rejected claims 22-23 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman* and *Goodwin* in view of U.S. Patent Publication No. 2005/0055321 ("*Fratkina*").

As Claims 22-23 depend from Claim 1, Claims 22-23 are patentable over *Enyart*, *Coleman*, and *Goodwin* for the reasons stated above. As the Examiner cites *Fratkina* merely for teaching a frequently asked questions database, *Fratkina* does not cure the deficiencies of *Enyart*, *Coleman* and *Goodwin*. Thus, Claim 1 and dependent Claims 22-23 are patentable over the combined teachings of *Enyart*, *Coleman*, *Goodwin*, and *Fratkina*. Reconsideration and allowance of Claims 22-23 are therefore requested.

Claim 34 over Enyart, Coleman, Goodwin, and Karamchedu

The Examiner rejected claims 34 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman* and *Goodwin*, further in view of U.S. Patent Publication No. 2004/0201625 ("*Karamchedu*").

Claim 34 depends from Claim 1, thus is patentable over *Enyart*, *Coleman*, and *Goodwin* combined for the reasons stated above. As the Examiner cites *Karamchedu* for merely teaching a daily limit on processing of certain emails, *Karamchedu* does not cure the deficiencies of *Enyart*, *Coleman* and *Goodwin*. Claim 34 is therefore patentable over the combined teachings of *Enyart*, *Coleman*, *Goodwin*, and *Karamchedu*. Reconsideration and allowance of Claim 34 are therefore requested.

Claims 27-30 over Enyart, Coleman, Goodwin, and Moskowitz

The Examiner rejected claims 27-30 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman* and *Goodwin*, and further in view of U.S. Patent No. 7,280,982 (“*Moskowitz*”).

As Claims 27-30 depend from Claim 1, Claims 27-30 are patentable over *Enyart*, *Coleman*, and *Goodwin* combined for the reasons stated above. As the Examiner cites *Moskowitz* for merely teaching certain mailbox services, *Moskowitz* does not cure the deficiencies in the teachings of *Enyart*, *Coleman*, and *Goodwin*. Thus, dependent Claims 27-30 are patentable over the combined teachings of *Enyart*, *Coleman*, *Goodwin*, and *Moskowitz*. Reconsideration and allowance of Claims 27-30 are therefore requested.

Claim 35 over Enyart, Coleman, and Moskowitz

The Examiner rejected claim 35 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman* and *Moskowitz*.

As Claim 35 depends from Claim 1, Claim 35 is patentable over *Enyart* and *Coleman*. As the Examiner cites *Moskowitz* merely for teaching deferring forwarding a message until a service is paid, *Moskowitz* does not cure the deficiencies of *Enyart* and *Coleman*. Thus, Claim 35 is patentable over the combined teachings of *Enyart*, *Coleman*, and *Moskowitz*. Reconsideration and allowance of Claim 1 are therefore requested.

Claim 9 over Enyart, Coleman, and Sweeney

The Examiner rejected claim 35 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman* and *Moskowitz*; rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman* and further in view of U.S. Patent Publication No. 2005/0004837 (“*Sweeney*”).

As Claim 9 depends from Claim 1, Claim 9 is patentable over *Enyart* and *Coleman* for the reasons stated above. As the Examiner cites *Sweeney* merely for teaching specifying a number of electronic addresses based on the content of messages to be received, *Sweeney* does not cure the deficiencies of *Enyart* and *Coleman*. Thus, dependent Claim 9 is patentable over the combined teachings of *Enyart*, *Coleman*, and *Sweeney*. Reconsideration and allowance of Claim 9 are therefore requested.

Claim 36 over Enyart, Coleman, Goodwin, and Sweeney


The Examiner rejected claim 36 under 35 U.S.C. § 103(a) as being unpatentable over *Enyart* in view of *Coleman* and *Goodwin*, and further in view of *Sweeney*.

As Claim 36 depends from Claim 1, Claim 36 is patentable over the combined teachings of *Enyart*, *Coleman*, *Goodwin*. As the Examiner cites *Sweeney* merely for teaching redirecting email messages of advertising interest, *Sweeney* does not cure the deficiencies of *Enyart*, *Coleman* and *Goodwin*. Thus, Claim 36 is patentable over *Enyart*, *Coleman*, *Goodwin*, and *Sweeney* for at least the same reason as Claim 1. Reconsideration and allowance of Claim 36 are therefore requested.

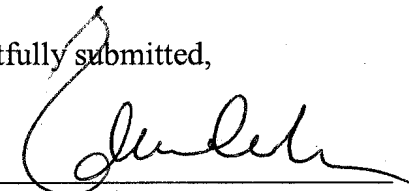
CONCLUSION

Therefore, Applicant requests reconsideration and allowance for Claims 1-46.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 08-1394 for any matter in connection with this response, including any fee for extension of time and/or fee for additional claims, which may be required.

<p>CERTIFICATE OF EFS-WEB TRANSMISSION Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's EFS-Web electronic filing system on <u>July 9, 2010</u>.</p> <p>Signature:  Annie Wong</p>
--

Respectfully submitted,


Edward C. Kwok
Attorney for Applicant
Reg. No. 33,938

Haynes and Boone, LLP
2033 Gateway Place, Suite 400
San Jose, CA 95110
Tel: 408-660-4120
Fax: 214-200-0853
E-mail: ipdocketing@haynesboone.com